

REMARKS

I. Status of the Claims

Applicant submits this Amendment in reply to the final Office Action dated July 21, 2009. Claims 1-3, 6, 8, 9, 14, 17, 22, 28-34, 36-42, 45-53, 60-64, and 66-76 are the pending, non-withdrawn claims in this application. By this Amendment, Applicant has amended claims 1, 22, 36, 49, 60, 61, 62, and 66; canceled claims 3, 32, 40, 45, 47, 67, and 68, without prejudice or disclaimer; and added new claims 78-84. The originally-filed specification, claims, abstract, and drawings fully support the subject matter of the amended and new claims.

In the Office Action, all of the pending claims are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,669,239 to Tobita ("*Tobita*"). In so far as the Examiner deems the rejections to apply to the claims as amended, Applicant respectfully traverses for at least the following reasons.

II. Independent Claims

Independent claims 1, 22, 36, 49, 60, 61, 62, and 66 each recites, among other things, a medical device comprising an elongated body portion including a plurality of interconnected loops and a non-loop segment having "a first end directly connected to a first loop of the interconnected loops and a second end directly connected to a second loop of said interconnected loops, wherein the non-loop segment is a single piece of material." *Tobita* fails to disclose or suggest at least these claimed features.

In rejecting the independent claims, the Office Action points to Fig. 7 of *Tobita* and appears to rely on a pin member 1 and a nut 8 of an earring as allegedly corresponding to the claimed non-loop segment. (Office Action at p. 3.) Moreover, the Office Action, “as an obvious matter of design choice,” appears to modify the Fig. 7 embodiment to include the sphere and chain elements of Fig. 8 at each end of the earring, allegedly resulting in a “body portion [comprising of] a plurality of interconnected loops.” *Id.* Even assuming the Office Action’s characterizations are correct, which Applicant does not concede, *Tobita* fails to disclose or suggest a non-loop segment that “is a single piece of material” and includes “a first end directly connected to a first loop of the interconnected loops and a second end directly connected to a second loop of said interconnected loops,” as recited in claims 1, 22, 36, 49, 60, 61, 62, and 66.

In contrast, *Tobita* discloses that the pierced earring device is a two-piece construction including pin member 1 and nut 8. As disclosed in Figs. 4, 6, and 7, for example, pin member 1 “is inserted through the hole in the earlobe E and then the nut 8 is fixed to the pin member 1 from behind the earlobe.” (*Tobita*, col. 4, lines 37-39.) To work, pin member 1 and nut 8 must be separate pieces that move relative to each other.

Because pin member 1 and nut 8 are two separate elements, they are not a non-loop member that is “is a single piece of material,” as recited in claims 1, 22, 36, 49, 60, 61, 62, and 66.

Furthermore, modifying the pierced earring device of *Tobita* so that at least pin member 1 and nut 8 are “a single piece of material,” as recited in the independent claims, would be undesirable and counter the primary teachings of *Tobita*. As discussed above, pin member 1 is inserted through earlobe E, then nut 8 is fixed to pin

member 1, and “[t]he pierced earring as an accessorial article thus is set into a state of use.” (*Tobita*, col. 4, lines 43-44.) Conversely, nut 8 is detached from pin member 1 to remove the pierced earring from earlobe E. Clearly, the two-piece construction of pin member 1 and nut 8 is a fundamental feature of the pierced earring device. Modifying the pin member 1 and nut 8 to be “a single piece of material” would hinder the intended purpose and specific use of the pierced earring device of *Tobita*. For example, if pin member 1 and nut 8 were a single piece of material, pin member 1 would be obstructed by nut 8 and its insertion into earlobe E would be obstructed. Such a modification would hinder the use of the *Tobita* pierced earring device as a decorative ornament for the ear. Therefore, one of ordinary skill in the art would not be motivated to modify the *Tobita* device, as that would destroy the specific use and intended purpose taught in *Tobita*.

For at least these reasons, claims 1, 22, 36, 49, 60, 61, 62, and 66 patentably distinguish from the cited references, and Applicant requests allowance of those claims.

III. Dependent Claims

Dependent claims 2, 6, 8, 9, 14, 17, 28-31, 33, 34, 37-39, 41, 42, 46, 48, 50-53, 63, 64, and 69-84 depend either directly or indirectly from either claim 1, 22, 36, 49, 60, 61, 62, and 66 and are patentable for at least the same reasons. In addition, these dependent claims recite unique combinations that are neither taught nor suggested by *Tobita*, and therefore also are separately patentable for these recitations. For example, *Tobita* fails to disclose the features of new dependent claim 77-84. *Tobita* fails to teach or suggest that “an outer surface of the non-loop segment is wavy.”

IV. Conclusion

Applicant respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered, placing claims 1, 2, 6, 8, 9, 14, 17, 22, 28-31, 33, 34, 36-39, 41, 42, 46, 48-53, 60-64, 66, and 69-84 in condition for allowance. Applicant respectfully points out that the final action presented some new arguments as to the application of the art against Applicant's invention. It is respectfully submitted that the entering of the Amendment would allow the Applicant to reply to the final rejections and place the application in condition for allowance. Finally, Applicant submits that the entry of the Amendment would place the application in better form for appeal, should the patentability of the pending claims be disputed.

In view of the foregoing remarks, Applicant submits that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the reference cited against this application. Applicant therefore requests the entry of this Amendment, reconsideration, and reexamination of the application, and the timely allowance of the pending claims.


The Office Action contains characterizations of the claims and the related art, with which Applicant does not necessarily agree. Unless expressly noted otherwise, Applicant declines to subscribe to any statement or characterization in the Office Action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: September 18, 2009

By: 
Daniel G. Chung
Reg. No. 63,553